

REMARKS

Claims 1-25 are currently pending in the subject application and are presently under consideration. Favorable reconsideration of the subject patent application is respectfully requested in view of the comments made herein.

I. Rejection of Claims 1-3, 14-17, and 22 Under 35 U.S.C. §102(b)

Claims 1-3, 14-17, and 22 stand rejected under 35 U.S.C. §102(b) as being anticipated by Bressers (U.S. Patent No. 4,730,295). It is submitted that this rejection be withdrawn for at least the following reasons.

Bressers does not disclose a housing with an opening *for receiving light from a scanned dataform*, as recited in claims 1 and 17. A rejection for anticipation under section 102 requires that each and every limitation of the claimed invention be disclosed in a single reference. *In re Paulsen*, 30 F.3d 1475, 31 USPQ2d 1671 (Fed. Cir. 1994) (emphasis added). In the Office Action dated January 4, 2002, the Examiner relies on notation (O) in Fig. 1 of Bressers as being the opening. However, opening (O) does not receive light from a scanned dataform. Rather, opening (O) receives a read beam b produced by a radiation source that has been reflected by an optical information structure in a record carrier.

Regarding the rejection of claim 22, Bressers does not disclose a prism mounted on an aperture, as recited in claim 22. Rather, as can be seen from Fig. 1 of Bressers, there is a gap between prism 6 and the opening indicated by Examiner's notation (A). Further, Bressers describes a double wedge 14 arranged on the exit face 11 of the prism. Bressers is silent on how prism 6 is mounted to the read apparatus.

Therefore, because Bressers does not expressly or inherently describe each and every element of claims 1, 17, and 22, Bressers does not anticipate these claims. Accordingly, withdrawal of this rejection and allowance of claim 1, claims 3 and 14-16, which depend therefrom, and claims 17 and 22 are respectfully requested.

II. Rejection of Claims 22-24 Under 35 U.S.C. §102(b)

Claims 22-24 stand rejected under 35 U.S.C. §102(b) as being anticipated by Guillot *et al.* (U.S. Patent No. 5,793,037). It is submitted that this rejection be withdrawn for at least the following reasons.

Guillot *et al.* does not disclose a prism mounted on an aperture, as recited in claim 22. Rather, Guillot *et al.* describes a prism 32 with a collar applied against an abutment 31e provided at the back of a hood 31, recessed into the latter, while an anterior edge of optical part 21 is applied against the rear surface of collar 32e (col. 2, lines 22-26). Further, optical part 21 comprises a front wall 21b fitted with two lenses 21c and 21d (col. 2, lines 2-7). Thus, it is submitted that notation (A) made by the Examiner in Fig. 3 of Guillot *et al.* is not an aperture, but one of the lenses 21c and 21d, as described in the specification. Accordingly, an image sensor having an aperture and a prism mounted on the aperture, as recited in claim 22 is absent from Guillot *et al.*

Because Guillot *et al.* does not expressly or inherently describe each and every element of claim 22, Guillot *et al.* does not anticipate claim 22. Withdrawal of this rejection and allowance of claim 22 and claims 23-24, which depend therefrom, are respectfully requested.

III. Rejection of Claims 1-5, 8, 9, 12, 14-18, and 22 Under 35 U.S.C. §102(b)

Claims 1-5, 8, 9, 12, 14-18, and 22 stand rejected under 35 U.S.C. §102(b) as being anticipated by Ogura *et al.* (U.S. Patent No. 5,825,560). It is submitted that this rejection be withdrawn for at least the following reasons.

Ogura *et al.* does not disclose a housing with an opening *for receiving light from a scanned dataform*, as recited in claims 1 and 17. Rather, Ogura *et al.* is directed to an apparatus for forming an object image on a solid-state imaging sensing element through a photographing optical member. Thus, the opening in the housing of Ogura *et al.* is for receiving a photographed image and not a scanned dataform.

Regarding the rejection to claim 22, Ogura *et al.* does not disclose an image sensor having an aperture. Rather, in Ogura *et al.*, a solid-state image sensing element 2 is mounted on a lower surface of a board 1, and in particular, under one of a plurality of openings 1c in the

board. Thus, in Ogura *et al.* the board 1 has an aperture 1c; the image sensing element 2 does not.

Accordingly, because Ogura *et al.* does not expressly or inherently disclose each and every element of claims 1, 17, and 22, Ogura *et al.* does not anticipate claims 1, 17, and 22. Withdrawal of this rejection and allowance of claim 1, claims 2-5, 8, 9, 12, and 14-16, which depend therefrom, claim 17, claim 18, which depends therefrom and claim 22 are respectfully requested.

IV. Rejection of Claims 1-5, 8, 9, 12, 17, 18, and 22 Under 35 U.S.C. §102 (b)

Claims 1-5, 8, 9, 12, 17, 18, and 22 stand rejected under 35 U.S.C. §102(b) as being anticipated by Shepard (U.S. Patent No. 3,341,711). It is submitted that this rejection be withdrawn for at least the following reasons.

Shepard does not disclose a housing with an opening *for receiving light from a scanned dataform*, as recited in claims 1 and 17. Rather, Shepard is directed to controlling the automatic activation and deactivation of light controlled lighting fixtures. Thus, opening 26 of housing 19 receives ambient light from the environment and not light from a scanned dataform.

Regarding the rejection to claim 22, Shepard does not disclose an *image sensor* having an aperture. Rather, Shepard merely describes a light sensitive cell coupled to a photoelectric control switch. Moreover, Shepard does not disclose a prism mounted on an aperture, as recited in claim 22. Instead, as can be seen in Fig. 2 of Shepard, prism 28 is attached to light control cylinder 36.

Accordingly, because Shepard does not expressly or inherently disclose each and every element of claims 1, 17, and 22, Shepard does not anticipate claims 1, 17, and 22. Withdrawal of this rejection and allowance of claim 1, claims 2-5, 8, 9, 12, and 14-16, which depend therefrom, claim 17, claim 18, which depends therefrom and claim 22 are respectfully requested.

V. Rejection of Claims 13, 19, and 25 Under 35 U.S.C. §103 (a)

Claims 13, 19, and 25 stand rejected under 35 U.S.C. §103 (a) as being unpatentable over Ogura, *et al.* (U.S. Patent No. 5,825,560). It is submitted that this rejection be withdrawn for at least the following reasons.

Claims 13, 19, and 25 depend from independent claims 1, 17, and 22, which are believed to be allowable for the aforementioned reasons. Accordingly, claims 13, 19, and 25 are not obvious over Ogura *et al.* Withdrawal of this rejection and allowance of claims 13, 19, and 25 are respectfully requested.

VI. Rejection of Claims 6, 7, 10, 11, 20, 21, 23, and 24 Under 35 U.S.C. §103 (a)

Claims 6, 7, 10, 11, 20, 21, 23, and 24 stand rejected under 35 U.S.C. §103 (a) as being unpatentable over Shepard (U.S. Patent 3,341,711). It is submitted that this rejection be withdrawn for at least the following reasons.

Claims 6, 7, 10, 11, 20, 21, 23, and 24 depend from independent claims 1, 17, and 22, which are believed to be allowable for the aforementioned reasons. Accordingly, claims 6, 7, 10, 11, 20, 21, 23, and 24 are not obvious over Shepard. Withdrawal of this rejection and allowance of claims 6, 7, 10, 11, 20, 21, 23, and 24 are respectfully requested.

VII. Objection to Drawings

The drawings have been objected to under 37 CFR 1.83(a) for failing to show every feature of the invention specified in the claims.

Filed concurrently herewith is a Request for Approval of Drawing Changes, wherein Fig. 5 has been deleted and Figs. 5A and 5B have been added in accordance with MPEP §2163.06. No new matter has been introduced by the Proposed Drawing Changes. According to MPEP §2163.06, information contained in any one of the specification, claims or drawings of the application as filed may be added to any other part of the application without introducing new matter. Support for the addition of Fig. 5A is present in the specification at page 11, line 6 through page 12, line 25. Support for the addition of Fig. 5B is present in the specification at page 12, line 26 through page 13, line 3. Thus, withdrawal of this objection is requested.

CONCLUSION

The present application is believed to be condition for allowance in view of the above remarks. A prompt action to such end is earnestly solicited.

Should the Examiner believe a telephone interview would be helpful to expedite favorable prosecution; the Examiner is invited to contact applicant's undersigned representative at the telephone number listed below.

In the event any fees are due in connection with the filing of this document, the Commissioner is authorized to charge those fees to Deposit Account No. 50-1063.

Respectfully submitted,
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